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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/770,616

02/02/2004

Wolfgang Eis

AMB-131-01

2302

24131 7590 06/10/2010
LERNER GREENBERG STEMER LLP
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

DEGHAN, QUEENIE S

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/10/2010

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG EIS and LOTHAR WILLMES

Appeal 2009-005148
Application 10/770,616
Technology Center 1700

Decided: June 9, 2010

Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-6, 9, and 11-26. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

Claim 1, the sole independent claim, is representative (emphasis added):

1. A device for making up a plurality of optical fibers, comprising:

a multifiber drawing machine having a drawing installation and a take-up winder;

said drawing installation being configured to synchronously produce a plurality of individual optical fibers, and said drawing installation being configured to provide a drawing rate for drawing the plurality of individual optical fibers such that the drawing rate is substantially constant and substantially identical for each of the optical fibers;

said take-up winder having a take-up spool and a compensating device;

said take-up spool taking up the optical fibers;

said compensating device being configured such that, when the optical fibers have respective different speeds at said drawing installation and at said take-up spool, said compensating device compensates for differences in speed between said drawing installation and said take-up spool;

said compensating device having a speed-change compensating device for compensating a change in speed of a fiber bundle wound in layers onto said take-up spool, said speed-change compensating device configured to compensate a change in speed in at least one situation selected from the group consisting of a change in speed of the fiber bundle when changing from one of the layers to another one of the layers and a change in speed of the fiber bundle resulting from a changing radius of the layers wound-up on said take-up spool;

said speed-change compensating device having a dancing arm fastened at a mounting point;

said speed-change compensating device having a deflection roller for guiding the fiber bundle;

said deflection roller rotatably fastened to said dancing arm such that said deflection roller is held on one side of said dancing arm and such that said deflection roller is pivotable about the mounting point of said dancing arm in a plane substantially parallel to a plane of rotation of said take-up spool; and

said deflection roller held on said dancing arm *such that said deflection roller, in addition to performing a pivoting movement about the mounting point of said dancing arm, can oscillate separately with respect to the pivoting movement.*

The Examiner maintained, and Appellants seek review of, the following rejections:

1) claims 1-3, 9, 14, 16-22, and 26 under 35 U.S.C. § 102(b) as anticipated by Fulk¹;

2) claim 4 under 35 U.S.C. § 103(a) as unpatentable over Fulk and Collaro²;

3) claims 5-6 and 15 under 35 U.S.C. § 103(a) as unpatentable over Fulk, Collaro, and Hendrix³;

4) claims 11-13 under 35 U.S.C. § 103(a) as unpatentable over Fulk and Canfield⁴; and

¹ US 3,847,579 issued November 12, 1974

² US 2005/0126227 A1 published June 16, 2005

³ US 4,130,248 issued December 19, 1978

⁴ US 3,650,717 issued March 21, 1972

5) claims 23-25 under 35 U.S.C. § 103(a) as unpatentable over Fulk and Stream⁵.

Appellants have not separately argued any of the dependent claims in the first ground of rejection, nor do they present any additional arguments with respect to grounds of rejection 2), 3) and 5); they focus only on independent claim 1 (Br. 6-11, 14). With respect to the fourth ground of rejection, Appellants separately argue dependent claims 11 and 12 as a group, but do not present any arguments regarding dependent claim 13 (Br. 11-13).

Accordingly, we also focus on claim 1 to decide the main issue on appeal; *see* 37 C.F.R. § 41.37(c)(1)(vii). We also select claim 11 to decide the issue represented in the third rejection on appeal.

ISSUES ON APPEAL

The first issue is: Has the Examiner erred in rejecting the claims because Fulk's deflection roller 52 does not have the capability of pivoting and oscillating as recited in claim 1? This issue turns on the broadest reasonable interpretation of the claim language.

We answer this question in the negative.

The second issue is: Has the Examiner erred because there is no reasonable suggestion to modify Fulk's pivotally mounted arm 56 to be "elastic" as recited in claim 11, since such a flexible arm would have rendered Fulk unsuitable for its intended purpose? This issue turns on the reasonable expectation of success resulting from the Examiner's proposed modification of Fulk with Canfield.

We answer this second question in the affirmative.

⁵ US 2,622,810 issued December 23, 1952

PRINCIPLES OF LAW

It is well established that while the features of an apparatus claim may be recited functionally, the apparatus must be distinguished from the prior art in terms of structure, rather than function. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

During examination, claim terms must be given their broadest reasonable construction consistent with the Specification. *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007).

This approach is not unfair to applicants, because “before a patent is granted the claims are readily amended as part of the examination process.” *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1583 (Fed. Cir. 1987). It also “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984).

ANALYSIS

with Findings of Fact

We adopt the Examiner’s detailed factual findings stated in the Answer (Ans. 4-7) and Final Office Action (3-6), as well as the Examiner’s findings of fact in response to the Appeal Brief as set out on pages 7-10 of the Answer in the “Response to Argument” section, unless overturned in whole or in part below.

Appellants’ sole argument, with respect to the § 102 rejection, is that Fulk does not describe a deflection roller that can oscillate separately with respect to a pivoting movement about the mounting point (Br. 6). In other words, Appellants contend that the Examiner has unreasonably construed this claimed feature to encompass the movements of the deflection roller 54

of Fulk with its pivotally mounted arm 56 and other associated structure (*id.*). We disagree for the reasons articulated by the Examiner (*e.g.*, Ans. 9, 10).

In addition, since the claim limitation in question is functional language concerning how the roller is able to move, the proper focus is whether the roller of Fulk is capable of functioning as claimed, that is, to pivot and oscillate separately. *See e.g., In re Schreiber*, 128 F.3d at 1478-1479 (finding that the structure of the prior art was inherently of a size and shape capable of functioning as claimed).

We determine that the Examiner's findings reasonably establish that Fulk's roller is capable of oscillating and pivoting as recited in claim 1. Appellants even admit that deflection roller 54 of Fulk "oscillates or pivots about the shaft 182" (Br. 6). Appellants contend, however, that the shaft 182 of Fulk does not "undergo a vertical movement, a horizontal movement, or any other type of translational movement" (Br. 6). As the Examiner fully explains, the claim does *not* require the mounting point (*i.e.*, the pivot point) of the dancing arm to undergo a vertical, horizontal, or translational movement (Ans. 9, 10). Indeed, as aptly noted by the Examiner, Appellants' Specification does not describe any of these types of movement for the pivot point of its pivotal arm 12, nor for the arm *per se* (Ans. 10).

We see no basis in the claim language or Specification which warrants interpretation of claim 1 as requiring any additional movement capabilities of Fulk's deflection roll 54. Accordingly, we find no basis in the language of claim 1 or in the disclosure in the Specification on which to read the disputed language as urged by Appellants.

Furthermore, Appellants have not disputed any of the Examiner's findings at pages 9-10 of the Answer, including that (1) the pivoting and oscillating movements of Appellants' roller 13 as described in their Specification are essentially the same movement, performed at separate times, and (2) Fulk teaches an oscillating movement of its roller 54 that is generated by the spring 58 while a separate pivoting movement is provided about the point intercepted by arms 210 and 220 (*note*, no Reply Brief has been filed).

Thus, we sustain the Examiner's § 102 rejection based on Fulk, as well as the Examiner's § 103 rejections based on Fulk wherein Appellants rely only on the arguments made with respect to claim 1, and present no additional arguments (*i.e.*, grounds of rejection 2, 3, and 5 as listed on pp. 3-4 of this Decision).

With respect to dependent claim 11 as rejected in the fourth ground of rejection, Appellants' arguments that there is no suggestion to modify Fulk to make its dancing arm of an elastic material based on the teachings regarding flexible arm 52 of Canfield are persuasive (Br. 11-13). The shoe 55 (deflection roller) of Canfield is mounted on rigid arm 51, which in turn is mounted on the flexible arm 52 relied upon by the Examiner, which in turn is fixedly secured to securing block 53. Deflection roller 55 of Canfield is not pivotable as required by claim 11.

Thus, the weight of the evidence supports Appellants' position that there is no suggestion to combine "certain parts of the different tensing sensing structures" of Fulk and Canfield (Br. 13), and that modifying the arm of Fulk to be of an elastic material would result in "inaccurate" tension measurements (*id.*). It is apparent that the combination proposed by the

Examiner in this rejection is based upon impermissible hindsight derived from the Appellants' own disclosure. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Accordingly, we reverse the Examiner's § 103 rejection of claims 11 and 12 based on Fulk and Canfield, however, we affirm the rejection of claim 13 included therein since Appellants separately argued only claims 11 and 12, and presented no arguments directed to the rejection of dependent claim 13 (Br. 11-13).⁶

CONCLUSION and ORDER

The Primary Examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED-IN-PART

kmm

LERNER GREENBERG STEMER LLP
P.O. BOX 2480
HOLLYWOOD, FL 33022-2480

⁶ Claim 13 merely requires that the arm be of a given thickness or shape such that it has a given oscillating capability; it does not require the arm to be elastic (*see* claim 13). Since the arm 56 of Fulk inherently has a given thickness or shape resulting in a given oscillating capability, we determine claim 13 would have been obvious over Fulk alone.